

REMARKS

Claims 1-30 are pending in the instant application. In the Office Action, claims 1-30 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over publications No. JP 11-341452 (hereinafter, "Shimizu"), No. JP 09-091869 (hereinafter, "Kato") and No. JP 11-027508 (hereinafter, "Takahashi"). Applicant respectfully traverses the rejection, for at least the following reasons.

Applicant respectfully submits that the Office Action has not made out a *prima facie* case that the claims are obvious, nor that the references teach or fairly suggest what is attributed to them. For example, the Office Action alleges that Shimizu teaches the features of claim 1, except that the watermark relates to copyright information (p. 3). The Office Action refers to a "Process of Logging On" section that does not appear in either the English language abstract of Shimizu in the IDS submitted 15 November 2004, nor anywhere in the corresponding English language equivalent U.S. Pat. No. 6,971,012. Therefore, there is no evidence of record that Shimizu teaches what is attributed to it in the Office Action.

Moreover, the Office Action improperly removes a key term from the recitation of the claim, namely the "detection result adjustment means for [adjusting] a detection [result] of said electronic watermark..." (ellipses from Office Action p. 2 replaced). The words excised by the Office Action significantly alter the meaning of the recited claim element. The claim rejected in the Office Action does not even remotely resemble the claim on file. It has been held by the courts that the Office may not properly dissect a claim, excise subject matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. See, *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) (citing *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1, 9

(1980)). See also, Department of Commerce, Patent and Trademark Office, "Examination Guidelines for Computer-Related Inventions," § II(B), 61 Fed. Reg. 7478, 7480 (Feb. 28, 1996).

Turning now to the additional references of Takashi and Kato, the Office Action's characterizations of these references are also not supported by the text of the English language abstracts, nor any other English language document of record. For example, Takahashi makes no mention of copyright data on the face of its English language abstract. Therefore, the assertions as to the teachings of these references are insufficient. Assertions not based upon any evidence of record lack substantial evidence support, and should be reversed. See, *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999).

Moreover, Kato pertains to a digital recording device, which is completely non-analogous to watermark detection apparatus. Therefore, even assuming *arguendo*, that Kato teaches what is attributed to it, one skilled in the art would not look to a digital recording device such as Kato to combine with an electronic image watermark system of Shimizu. "Those of ordinary skill in the art may be presumed to have knowledge of arts "reasonably pertinent to the particular problem with which the inventor was involved." *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). However, that prior art may not be gathered with the claimed invention in mind. *In re Antle*, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971)." *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766, 768-69 (Fed Cir, 1985)

Therefore, because the Office Action does not set forth evidence to support the asserted teachings of the references; because the claims were substantively altered to reach the determination that their features are taught by the references; and because even presuming the references teach what is attributed to them, the rejection proposes a combination of non-

analogous art, Applicant respectfully submits that the rejection is poorly taken, and kindly requests favorable reconsideration and withdrawal. Only claims 1-10 are addressed in any depth in the Office Action. Claims 11-20 and 21-30 are rejected as analogous to claims 1-10. Claims 2-10 each depend, either directly or indirectly, from claim 1. These dependent claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claim. Claims 12-20 depend from independent claim 11, and claims 22-30 depend from independent claim 21. As the Office Action extends the rejection to these claims by analogy, the insufficiency of the rejection similarly compels that the rejection of all claims be reconsidered and withdrawn.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicits an early notice of allowability. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



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